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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,111	02/15/2002	C. Gordon Todderud	D0031 NP	1564

7590 09/22/2006

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EXAMINER

ZARA, JANE J

ART UNIT PAPER NUMBER

1635

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/077,111	Applicant(s) TODDERUD ET AL.	
	Examiner Jane Zara	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,9-14,18,19,21,25,27,32-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9-14,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,32-35 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 25 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-3-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the communication filed 7-3-06.

Claims 5, 6, 9-14, 18, 19, 21, 25-28, 32-35, 37-40 are pending in the instant application.

Election/Restrictions

This application contains claims 5, 6, 9-14, 18 and 19, drawn to an invention nonelected with traverse in the election filed 6-9-04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments and Amendments

Claims 21, 32-35, 37-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record set forth in the Office action mailed 12-29-05 and for the reasons set forth below.

Applicant has made no new arguments addressing this rejection.

The claims are drawn to isolated polynucleotides and methods comprising a nucleotide sequence at least 97% identical to SEQ ID NO: 12. The specification and claims do not adequately describe the elements essential to the genera comprising these sequence variants, nor do they describe the genus comprising a cell signaling polypeptide involved in a cell signaling cascade or ubiquitin conjugating enzyme or

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fragment thereof having at least 97% identity with SEQ ID NO: 12. The disclosure does not clarify the common attributes encompassed by this genus.

The scope of the claims includes numerous structural variants and a significant number of structural differences between members of the genus is permitted. Concise structural features that distinguish structures within the genus are missing from the disclosure and the claims. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus claimed. Thus, Applicant was not in possession of the claimed genus.

The genus presently claimed - encompassing any polynucleotide sequence sharing at least 97% identity with SEQ ID NO: 12 - comprises a myriad of sequences and the instant disclosure does not adequately describe a representative number of species that perform the function claimed, of encoding cell signaling polypeptides involved in cell signaling cascades that share 97% sequence identity with SEQ ID NO> 12. A representative number of species of polypeptides with the function claimed must be adequately described and must fairly represent the variation encompassed within the entire genera. The specification describes various WD, SAM and U-box domains within the polypeptide claimed, as well as splice variations which lack some of these common domains or motifs. The presence of these common motifs, however, does not address the question of what structures are required for defining members of the broad genus claimed from those outside of the claimed genus. Because the prior art is silent with respect to what structures are precisely required beyond the presence of well known domains, disclosure of a polypeptide comprising the common motifs of WD, SAM and

U-box domains does is not sufficient to fulfill the written description requirement of the genus claimed. One of skill in the art would conclude that Applicant was not in possession of the claimed genus.

Allowable Subject Matter

Claims 25, 27 are objected to because they depend from a rejected claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. ' 1.6(d)). The official fax telephone number for the

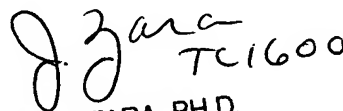
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Group is **571-273-8300**. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(571) 272-0765**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on (571) 272-4517. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jane Zara
9-14-06


JANE ZARA, PH.D.
PRIMARY EXAMINER